



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,888	01/11/2005	Kazuhiko Miyazawa	05003/HG	6374
1933	7590	03/07/2006	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			LETSCHER, GERALDINE	
220 Fifth Avenue			ART UNIT	PAPER NUMBER
16TH Floor			1752	
NEW YORK, NY 10001-7708			DATE MAILED: 03/07/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/520,888	MIYAZAWA ET AL.	
	Examiner	Art Unit	
	Geraldine V. Letscher	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 28 December 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

This office action is responsive to the Amendment filed December 28, 2005.

Claim 13 has been added. Claims 1-13 are presently under consideration.

Claim 1, as originally filed, recited the difference between the maximum VE value and the minimum VE value as "between 0.0-0.2"; the prior art of record teaches the difference between the maximum VE value and the minimum VE value as 0.0 to 0.08. In response to the first office action on the merits, applicants have amended the base independent claim 1 to overcome the rejections under 35 USC 102, by further limiting the difference between the maximum VE value and the minimum VE value to "between greater than 0.08 and 0.2".

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. (U.S. Patent Application Publication No. 2003/0203328).

Murakami et al. discloses a silver halide color photographic material and corresponding method of forming an image thereof including exposing the material at an exposure time of  $10^{-10}$  to  $10^{-3}$  seconds per pixel and conducting color photographic processing on the exposed material, said photographic material comprising a support having thereon a yellow color image-forming silver halide emulsion layer, a magenta

color image-forming silver halide emulsion layer, and a cyan color image-forming silver halide emulsion layer, characterized in that the difference between the maximum VE value and the minimum VE value is between 0.0 and 0.08.

It would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to utilize the silver halide color photographic material of Murakami et al., to obtain an image characterized in that the difference between the maximum VE value and the minimum VE value is between greater than 0.08 and 0.20, absent object evidence to the contrary, with reasonable expectations of achieving the advantages taught therein. Please refer to paragraph 4 for additional comments.

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being obvious over Ikeda et al. (U.S. Patent No. 6,750,001).

Ikeda et al. discloses a silver halide color photographic material and corresponding method of forming an image thereof including exposing the material at an exposure time of  $10^{-10}$  to  $10^{-3}$  seconds per pixel and conducting color photographic processing on the exposed material, said photographic material comprising a support having thereon a yellow color image-forming silver halide emulsion layer, a magenta color image-forming silver halide emulsion layer, and a cyan color image-forming silver halide emulsion layer, characterized in that the difference between the maximum VE value and the minimum VE value is between 0.0 and 0.08.

It would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to utilize the silver halide color photographic material of Ikeda et

al., to obtain an image characterized in that the difference between the maximum VE value and the minimum VE value is between greater than 0.08 and 0.20, absent object evidence to the contrary, with reasonable expectations of achieving the advantages taught therein. Please refer to paragraph 4 for additional comments.

The applied reference has a common inventor/assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

4. The Examiner has reviewed the specification, particularly the experimental data herein, for indicia of unexpected results, as evidence of unobviousness thereof, including an evaluation of the impact of silver halide photographic material

characterized in that the difference between the maximum VE value and the minimum VE value to "between greater than 0.08 and 0.2". There is nothing in the specification, as originally filed, indicating a "preferred" range in the difference between 0.0-0.20 as originally claimed. The examples herein the specification refer to a comparative sample, wherein the difference between the maximum VE value and the minimum VE value is 0.31, and inventive samples, wherein the difference between the maximum VE value and the minimum VE value is 0.19. To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960). The data herein the specification is insufficient to establish unexpected results over the claimed range of "between greater than 0.08 and 0.2". The difference between the maximum VE value and the minimum VE value achieved herein the specification do NOT occur over the entire claimed range.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geraldine V. Letscher whose telephone number is (571) 272-1334. The examiner can normally be reached 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GERALDINE LETSCHER  
PRIMARY EXAMINER  
GROUP 1100